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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,758	03/09/2004	Sjoerd Johannes van Driesten	AVERP3447USA	4363

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EXAMINER

TRAN, THAO T

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/796,758

Applicant(s)

DRIESTEN, SJOERD JOHANNES
VAN

Examiner

Thao T. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 25-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24, 41-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This is in response to the Amendments filed 11/19/2004.
2. Claims 1-44 are currently pending in this application. Claims 25-40 have been withdrawn as directed to a non-elected invention as indicated in the Office action of 8/26/2004. Claims 1, 21, 41, and 43 have been amended.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-11, 21, 23, 41, and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by MacGregor et al. (US Pat. 4,846,504).

MacGregor teaches a label assembly, comprising a backing tape 12 (carrier) with a release layer, bearing a series of labels (adhesive articles). Each of the labels is formed of a base label 20, a promotional label 22, and an outer label 24 (see Figure 1). The base label is secured to the backing tape with a permanent pressure-sensitive adhesive; the promotional label is slightly secured to the base label by a transparent, nontacky, peelable adhesive (removable); and the outer label is secured to the base label by a permanent pressure-sensitive, water-soluble adhesive (see col. 3, ln. 15-26).

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In regards to claims 1, 9, 21, 41, and 43, MacGregor teaches the promotional label (substrate) is formed of water-resistant material (see col. 4, ln. 49-50) and the peeling force of the removable or resealable adhesive covering the promotional label is approximately 0.7 lbs/in or 0.9 lbs/in (see col. 3, ln. 55-65; col. 4, ln. 4-7), which reads on the instantly claimed range.

Moreover, MacGregor teaches the removable and resealable adhesive to be acrylic-based or rubber-based hot melt pressure sensitive adhesive (see col. 3, ln. 66; col. 4, ln. 4-7, 42-47). Since MacGregor teaches the adhesive comprising the same chemical component as disclosed in the instant specification, MacGregor's adhesive would inherently have the same properties, such as the peeling force and cohesive strength.

Note: The examiner is interpreting the whole surface as a portion of the surface.

In regards to claims 2-7, MacGregor further teaches the base label and the promotional label are formed of water-resistant material, such as paper coated with varnish, or plastic films, such as polystyrene, polypropylene, or polyethylene (see col. 4, ln. 17-24, 48-67).

In regards to claims 8, 10-11, 23, MacGregor teaches the adhesive to be acrylic-based, rubber-based, or hot melt pressure sensitive (see col. 3, ln. 66; col. 4, ln. 9-11).

5. Claims 1-3, 8-11, 18-24, 41-44 are rejected under 35 U.S.C. 102(b) as being anticipated by Sorensen et al. (US Pat. 4,771,891).

Sorensen teaches a roll of backing strip with a release layer and labels (substrates) adhering to the release layer (see col. 2, ln. 36-40; col. 5, ln. 17-25). The adhesive is applied on selected areas of the label, including full coverage area 78, 18' where permanent adhesion is desired, and relatively lighter pattern coverage in the area 80, 84 where the label is releasable (removable) (see Figs. 9-10; col. 1, ln. 49-51; col. 6, ln. 65 to col. 7, ln. 13; claims 1, 10-11).

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Sorensen further teaches the adhesive to be acrylic-based, rubber-based, or hot melt pressure sensitive and that it has a peeling force of approximately 0.7 lbs/in and 0.9 lbs/in (see paragraph bridging col. 5-6; col. 6, ln. 55-69), which appears to read on the instantly claimed range.

Moreover, since Sorensen teaches the removable and resealable adhesive comprising the same chemical component as disclosed in the instant specification, Sorensen's adhesive would inherently have the same properties, such as the peeling force and cohesive strength.

Sorensen further discloses the substrate to be face stock coated with plastic coating, or notes (see col. 1, ln. 42-46; Fig. 7; col. 6, ln. 45-59).

6. Claims 1-5, 9-10, 12-18, 21-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Cameron et al. (US Pat. 6,025,071).

Cameron teaches an adhesive article, comprising a substrate and a removable and resealable adhesive (hot melt pressure sensitive adhesive) coated on the surface of the substrate (see col. 3, ln. 29-32; col. 7, ln. 10-12). The adhesive comprises about 10-50% by weight of at least one styrene-isoprene-styrene block copolymer; about 10-40% by weight of at least one tackifying resin; and about 10-50% by weight of plasticizers (see abstract). The copolymer component further includes about 0-30% by weight of the adhesive a styrene-butadiene-styrene block copolymer (see col. 4, ln. 28-45). The styrene-isoprene-styrene block copolymer comprises a mixture of triblock and diblock copolymers (see col. 3, ln. 64-65); the tackifying resin component includes a synthetic petroleum hydrocarbon resin having a softening point of 95oC (Wingtack 95) and tackifiers such as rosins, rosin esters, and polyterpenes (see col. 5, ln. 11-15, 37; col. 6, ln. 1-6).

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Moreover, since Cameron teaches the removable and resealable adhesive comprising the same chemical component as disclosed in the instant specification, Cameron's adhesive would inherently have the same properties, such as the peeling force and cohesive strength.

Cameron further teaches the substrate to be paper or polyester film and can be one layer or multilayer (see col. 7, ln. 21-51; col. 8, ln. 20-22, 42).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sorensen as applied to claim 1 above, and further in view of Cameron et al. (US Pat. 6,025,071).

Sorensen is as set forth in claim 1 above and incorporated herein.

Sorensen does not teach the adhesive comprising a styrene isoprene or styrene butadiene copolymer or the tackifiers as recited in the instant claims.

Cameron teaches an article having a removable hot melt pressure sensitive adhesive, the adhesive comprising a mixture of styrene-isoprene-styrene triblock and diblock copolymers; at least one tackifying resin, such as terpene and rosin (see abstract; col. 5, ln. 11-15).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have employed the adhesive, as taught by Cameron, in the adhesive composition of Sorensen. This is because Cameron discloses that the use of this adhesive

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composition would have resulted in excellent anchorage of the adhesive to the substrate, excellent quick tack and stain resistance, while retaining a low viscosity and low ultimate peel adhesion (see col. 3, ln. 12-16).

9. Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sorensen as applied to claim 1 above, and further in view of MacGregor.

Sorensen is as set forth in claim 1 above and incorporated herein.

Sorensen does not teach the substrate comprising a multilayer film, or that the substrate comprising a polymeric film as recited in the instant claims.

MacGregor teaches the substrate comprising multilayer film, such as paper coated with varnish, or plastic films, such as polystyrene, polypropylene, or polyethylene (see col. 4, ln. 17-24, 48-67). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have employed the substrate as plastic film comprising polystyrene, polypropylene, or polyethylene, as taught by MacGregor, in the adhesive article of Sorensen, and would have given the same results. This is because MacGregor discloses that the adhesive would be used on a paper coated with varnish or plastic films, and substituting one for another would have given the same effects. See MPEP 2144.06.

Response to Arguments

10. Applicant's arguments filed 11/19/2004 have been fully considered but they are not persuasive.

Throughout the Remarks, Applicant contends that the peeling force as taught by the references are not comparable to the presently claimed Moist Loop Test results and thus neither

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MacGregor nor Sorensen teaches the adhesive as presently claimed. However, as pointed out in the prior Office action and in the paragraphs above, although the references are silent with respect to the Moist Loop Test measurement at 50C, since the references teach the same chemical component, such as acrylic-based or rubber-based resin, in the adhesive, as presently claimed, the adhesive of the references would inherently have the same Moist Loop Test results. The same arguments are applied to Applicant's contention of the cohesive strength of the adhesive. With respect to the arguments that neither MacGregor nor Sorensen teaches the adhesive label to be resealable, Applicant is referred to the paragraphs above for reference of the removable and resealable being taught in the prior art.

Thus, Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

In response to applicant's argument that there is no suggestion to combine the references of Sorensen and Cameron, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Cameron is used to remedy the hot melt removable and resealable adhesive of Sorensen, and that a hot melt removable adhesive containing styrene-isoprene-styrene resins has been taught in the prior art.

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Contact Information

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thao T. Tran whose telephone number is 571-272-1080. The examiner can normally be reached on Monday-Friday, from 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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February 7, 2005

**THAO T. TRAN
PATENT EXAMINER**